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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/755,251	01/05/2001	Sergio Abrignani	CHIR-0309	6900

7590

10/15/2003

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EXAMINER

WORTMAN, DONNA C

ART UNIT

PAPER NUMBER

1648

DATE MAILED: 10/15/2003

23

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application N .

09/755,251

Applicant(s)

ABRIGNANI, SERGIO

Examiner

Donna C. Wortman, Ph.D.

Art Unit

1648

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 September 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. **ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).**

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
 - (b) ☐ they raise the issue of new matter (see Note below);
 - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
 - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☒ Applicant's reply has overcome the following rejection(s): Please see attached.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

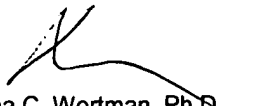
Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: 22, 23, and 26-29.

Claim(s) withdrawn from consideration: _____

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____
10. ☐ Other: _____


Donna C. Wortman, Ph.D.
Primary Examiner
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The after final amendment submitted 25 September 2003 has been entered. By its entry claims 21 and 25 are canceled and claims 22, 23, and 26 are amended.

Claims 22, 23, and 26-29 remain pending.

The amendments to claims 22, 23 and 26 have overcome the rejection under 35 USC 102(b)/103(a) over Levy et al. Levy et al. do not teach compositions comprising a truncated form of the TAPA-1/CD81 protein that lacks a functional portion of a transmembrane domain and that specifically binds the E2 protein of hepatitis C virus.

Rejections maintained

The provisional obviousness-type double patenting rejection of claims 22, 23, 26-29 over claim 17 of copending application 09/011910 is maintained for reasons of record.

The provisional obviousness-type double patenting rejection of claims 22, 23, 26-29 over claims 7 and 27-31 of copending application 09/509612 is maintained for reasons of record.

The rejection of claims 22, 23, and 26-29 under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention, is maintained for reasons of record.

Applicant has argued that the compositions as claimed that include a pharmaceutically acceptable carrier are suited for and enabled for additional uses, and has indicated provisional authorization to have the word "pharmaceutically" deleted by examiner's amendment if the case is otherwise allowable.

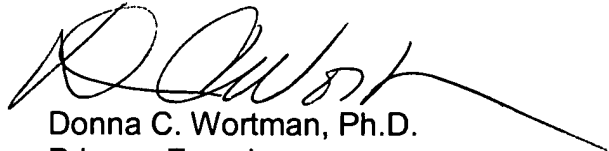
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Applicant's remarks have been considered but not found persuasive, since a composition claimed for pharmaceutical use must be enabled for its intended use; please see the final Office action mailed 6/27/2003 at paragraph bridging pages 4-5. Simply deleting "pharmaceutically" from the claims would not be sufficient to make the claims allowable, since claims 22 and 23 would then recite "... a(n) acceptable carrier" which would raise a new issue under 35 USC 112, first paragraph, as to whether there is support for an "acceptable" carrier broadly, as well as under 35 USC 112, second paragraph, as to what "acceptable" carrier means and encompasses other than the pharmaceutically acceptable carrier as now claimed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Donna C. Wortman, Ph.D. whose telephone number is 703-308-1032. The examiner can normally be reached on Monday-Thursday, 7:00-5:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Housel can be reached on 703-308-4027. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.


Donna C. Wortman, Ph.D.
Primary Examiner
Art Unit 1648

dcw